

Appeal Brief for App. No.: 10/812,380 (X) Related Proceedings Appendix



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in Re Leonard R. Kahn., 441 F.3d 977 (Fed. Cir. 2006)

Federal Circuits, Fed. Cir. (March 22, 2006)

Docket number: 04-1616

PTO

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2144.04 Legal Precedent as Source of Supporting Rationale [R-1] - 2100 Patentability

2144.04 Legal Precedent as Source of Supporting Rationale [R-1]

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

I. AESTHETIC DESIGN CHANGES

In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.). But see *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999) (The claims of a utility application, drawn to a generally round, orange plastic trash bag with a jack-o-lantern face, were rejected under 35 U.S.C. 103. However, the court reversed the rejection for lack of motivation to combine conventional trash bags with a reference showing a jack-o-lantern face on an orange paper bag stuffed with newspapers.); *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965) (Claims were directed to fried potato chips with a specified moisture and fat content, whereas the prior art was directed to french fries having a higher moisture content. While recognizing that in some cases the particular shape of a product is of no patentable significance, the Board held in this case the shape (chips) is important because it results in a product which is distinct from the reference product (french fries).).

II. ELIMINATION OF A STEP OR AN ELEMENT AND ITS FUNCTION

A. Omission of an Element and Its Function Is Obvious If the Function of the Element Is Not Desired

Ex parte Wu, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to

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establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

B. Changes in Shape

In *re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

C. Changes in Sequence of Adding Ingredients

Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render *prima facie* obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results); *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie* obvious.).

V. MAKING PORTABLE, INTEGRAL, SEPARABLE, ADJUSTABLE, OR CONTINUOUS**A. Making Portable**

In *re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) (Fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results.).

B. Making Integral

In *re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice."); but see *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." Nortron argued that the invention is just making integral what had been made in four bolted pieces.